

**Amendments to the Drawings:**

Please replace sheets 1, 2, 4 and 5 of the drawings with the attached replacement sheets 1, 2, 4 and 5. The replacement sheets incorporates the desired changes in the drawings, and includes all of the figures that appeared on the immediately prior version of that sheet.

Attachment: 4 Replacement Sheets

**Remarks:**

These remarks are responsive to the Office action dated March 23, 2005. Prior to the entry of this amendment, claims 1-32 remained pending in the application. Claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26 and 31 stand rejected under 35 U.S.C. § 102(b) based on Kanerva et al. (US 6,026,416). Claims 3-6, 8, 11-14, 16, 19-22, 24, 27-30 and 32 stand rejected based on Kanerva et al. in view of Hicks et al. (US 5,481,353). Applicant respectfully traverses the rejections for at least the reasons set forth below.

**Objections to the Drawings**

In the present Office action, the Examiner has objected to the drawing because they include several reference characters that are not included in the description. The applicant respectfully thanks the Examiner for this thorough analysis, and submits corrected drawing sheets 1, 2, 4 and 5 herewith, omitting the reference characters identified by the Examiner. However, Fig. 8 (reference character 808) remains unchanged. The paragraph commencing at line 6 on page 11 has been amended herein to include reference character 808 in the description.

**Rejection of Claims 1-8**

In the present Office action, claims 1-2 and 7 are rejected under 35 U.S.C. § 102(b) over Kanerva et al. (US 6,026,416). Claims 3-6 and 8 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Kanerva et al. discloses the method recited by claim 1. As amended, claim 1 recites, in part, a method including "specifying a set of individual printing characteristics with respect to each of the files; specifying a set of

individual packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files."

Kanerva et al. relates to a system and method for storing, viewing, editing and processing ordered sections of a binder document wherein the sections have different native file formats. Selected sections of the binder document can be printed as a single consecutively printed document without other print jobs interrupting or intervening between printed sections. However, Kanerva et al. fails to teach, disclose, or suggest either specifying a set of individual printing characteristics for each of the files, or specifying a set of individual packaging characteristics for each of the files, as recited in claim 1.

Kanerva et al. merely employs a binder program that "dispatches each section to be printed by the application program module that created each section." Kanerva et al. focuses on printing sections consecutively without other print jobs interrupting or intervening between sections. There is not even any discussion of individual printing characteristics and individual packaging characteristics of the various sections to be printed. Correspondingly, there is not any discussion of the potential for different printing characteristics or packaging characteristics between the various sections of the binder document. Accordingly, Kanerva et al. fails to disclose or suggest "printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files."

Since Kanerva et al. fails to disclose every element of claim 1, applicant submits that claim 1 is allowable and requests the withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) over Kanerva et al. Furthermore, since claims 2 and 7 depend from claim 1, applicant asserts that these claims are allowable for at least the same reasons as claim 1.

Turning now to claims 3-6 and 8, these claims have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al in view of Hicks et al. As amended, claim 3 recites, in part, a method including "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Similarly, amended claim 6 recites, in part, a method including "indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package." The Examiner has acknowledged that Kanerva et al. fails to disclose "identifying individual ones of the files that are not included in a general distribution package." The Examiner thus refers to Hicks et al.

Hicks et al. relates to an apparatus for producing variable feature presentation sets. The Examiner asserts that the transparencies, dividers, master set, and handout set(s) disclosed by Hicks et al. are analogous to the various subsets of files of claims 3-6 and 8. However, applicant notes that the several variable feature presentation sets disclosed by Hicks et al. do not correspond to presentation and general distribution packages, and thus are different from the first and second subsets of files currently recited in claim 3-6 and 8.

The several variable feature presentation sets disclosed by Hicks et al., are various ways to produce output of the same original document. Hicks et al. teaches that these variable feature presentation sets are created by modifying the original document and then adding other elements, on a page-by-page basis. Conversely, claims 3-6 and 8 recite identifying a subset of files that are to be included in the presentation package, and identifying a subset of files that are to be included in the general distribution package. Hicks et al. does not consider specifying such subsets of files. In fact, Hicks et al. does not even consider a general distribution package, a number of copies of which may be printed for audience distribution.

Therefore, Kanerva et al. and Hicks et al., taken either alone or in combination, fail to teach, disclose, or suggest every element of claim 3-6 and 8, as amended herein. Claims 3-6 and 8 are therefore allowable for at least these reasons. Furthermore, since claims 3-6 and 8 depend from claim 1, these claims are allowable for at least the same reasons as claim 1. The rejection of these claims under 35 U.S.C. § 103(a) thus must be withdrawn.

**Rejection of Claims 9-16**

In the present Office action, claims 9-10 and 15 are rejected under 35 U.S.C. § 102(b) over Kanerva et al. (US 6,026,416). Claims 11-14 and 16 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Kanerva discloses the computer-readable medium recited by claim 9. As amended, claim 9 recites, in part, a computer-readable medium including computer-executable instructions for "specifying a set of individual printing characteristics with respect to each of the files; specifying a set of individual

packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.”

As discussed above with reference to claim 1, Kanerva et al. fails to teach, disclose, or suggest either specifying a set of individual printing characteristics for each of the files, or specifying a set of individual packaging characteristics for each of the files, as recited in amended claim 9. Kanerva et al. instead focuses on printing sections consecutively without other print jobs interrupting or intervening between sections. There is not even any discussion of the potential for different printing characteristics or packaging characteristics between the various sections of the binder document. Kanerva et al. thus fails to disclose every element of claim 9, and the rejection of claim 9 under 35 U.S.C. § 102(b) over Kanerva et al. should be withdrawn. Furthermore, since claims 10 and 15 depend from claim 9, these claims are allowable for at least the same reasons as claim 9.

Claims 11-14 and 16 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. As amended, claim 11 recites “identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.” Similarly, amended claim 14 recites “indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package.” The Examiner has acknowledged that Kanerva et al. fails to disclose

"identifying individual ones of the files that are not included in a general distribution package," and thus refers to Hicks et al.

As noted above, Hicks et al. relates to an apparatus for producing variable feature presentation sets. However, Hicks et al. does not disclose distinct presentation and general distribution packages as recited in amended claims 11-14 and 16. Therefore, Kanerva et al. and Hicks et al., taken either alone or in combination, fail to teach, disclose, or suggest every element of claim 11-14 and 16, as amended herein. Claims 11-14 and 16 are therefore allowable for at least these reasons. Furthermore, since claims 11-14 and 16 depend from claim 9, these claims are allowable for at least the same reasons as claim 9. The rejection of these claims under 35 U.S.C. § 103(a) thus must be withdrawn.

**Rejection of Claims 17-24**

In the present Office action, claims 17-18 and 23 are rejected under 35 U.S.C. § 102(b) over Kanerva et al. (US 6,026,416). Claims 19-22 and 24 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Kanerva discloses the computing device recited by claim 17. As amended, claim 17 recites, a computing device including a processor configured to execute computer-executable instructions for "specifying a set of individual printing characteristics with respect to each of the files; specifying a set of individual packaging characteristics with respect to each of the files; and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files."

As discussed above, Kanerva et al. fails to teach, disclose, or suggest either specifying a set of individual printing characteristics for each of the files, or specifying a set of individual packaging characteristics for each of the files. Although Kanerva et al. does disclose printing sections consecutively without other print jobs interrupting or intervening between sections, there is no discussion of executing a single print request to print a presentation package that includes files specified in the presentation profile based, wherein the specified files are printed according to individual packaging characteristics and the individual printing characteristics corresponding to each such file. Kanerva et al. thus fails to disclose every element of claim 17, and the rejection of claim 17 under 35 U.S.C. § 102(b) over Kanerva et al. must be withdrawn. Furthermore, since claims 18 and 23 depend from claim 17, these claims are allowable for at least the same reasons as claim 17.

Claims 19-22 and 24 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. As amended, claim 19 recites "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Similarly, amended claim 22 recites "indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package." The Examiner has acknowledged that Kanerva et al. fails to disclose "identifying individual ones of the files that are not included in a general distribution package," and thus refers to Hicks et al.



However, as noted above, Hicks et al. does not disclose distinct presentation and general distribution packages. Therefore, Kanerva et al. and Hicks et al., taken either alone or in combination, fail to teach, disclose, or suggest every element of claims 19-22 and 24, as amended herein. Claims 19-22 and 24 are therefore allowable for at least these reasons. Furthermore, since claims 19-22 and 24 depend from claim 17, these claims are allowable for at least the same reasons as claim 17. The rejection of these claims under 35 U.S.C. § 103(a) thus must be withdrawn.

**Rejection of Claims 25-32**

In the present Office action, claims 25-26 and 31 are rejected under 35 U.S.C. § 102(b) over Kanerva et al. (US 6,026,416). Claims 27-30 and 32 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. (US 5,481,353).

The Examiner asserts that Kanerva discloses the computing device recited by claim 25. As amended, claim 25 recites, a user interface including areas for “specifying a set of individual printing characteristics with respect to each of the files”; “specifying a set of individual packaging characteristics with respect to each of the files”; and “responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.”

As discussed above, Kanerva et al. fails to teach, disclose, or suggest either specifying a set of individual printing characteristics for each of the files, or specifying a set of individual packaging characteristics for each of the files. There also is no discussion of executing a single print request to print a presentation package that includes files specified in the presentation profile based, wherein the specified files are printed according to individual packaging characteristics and the individual printing characteristics corresponding to each such file. Kanerva et al. thus fails to disclose every element of claim 25, and the rejection of claim 25 under 35 U.S.C. § 102(b) over Kanerva et al. must be withdrawn. Furthermore, since claims 26 and 31 depend from claim 25, these claims are allowable for at least the same reasons as claim 25.

Claims 27-30 and 32 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. As amended, claim 27 recites "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files." Similarly, amended claim 30 recites "indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package." The Examiner has acknowledged that Kanerva et al. fails to disclose "identifying individual ones of the files that are not included in a general distribution package," and thus refers to Hicks et al.

However, as noted above, Hicks et al. does not disclose distinct presentation and general distribution packages. Therefore, Kanerva et al. and Hicks et al., taken either alone or in combination, fail to teach, disclose, or suggest every element of claims 27-30 and 32, as amended herein. Claims 27-30 and 32 are therefore allowable for at least these reasons. Furthermore, since claims 27-30 and 32 depend from claim 25, these claims are allowable for at least the same reasons as claim 25. The rejection of these claims under 35 U.S.C. § 103(a) thus must be withdrawn.

Claim 25 has been presently amended to recite, in part, a user interface including "a second area for specifying a set of individual packaging characteristics with respect to each of the files; a third area for specifying a set of individual printing characteristics with respect to each of the files; and a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print request, the printing being based on the individual packaging and printing characteristics corresponding to each of the files."

As discussed above with reference to claims 1, 9, and 17, Kanerva et al. relates to a method, a computer readable medium, a computing device, and a user interface that allows for the creation of printed output of a plurality of files responsive to a single print request. However, Kanerva et al. fails to teach, disclose, or suggest user interface including either an area for specifying a set of individual printing characteristics for each of the files or an area for specifying a set of individual packaging characteristics for each of the files, as taught by the applicant in claim 25. Since Kanerva et al. fails to disclose every element of claim 25, the applicant submits that claim 25 is allowable and requests the withdrawal of the rejection of

claim 25 under 35 U.S.C. § 102(b) over Kanerva et al. Furthermore, since claims 26 and 31 depend from claim 25, the applicant asserts that these claims are allowable for at least the same reasons as claim 5.

Turning now to claims 27-30 and 32, these claims have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Kanerva et al. in view of Hicks et al. With this amendment, claim 27 has been amended to recite, in part, a user interface including an area for "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, different from the presentation package." Similarly, claim 30 has been amended to recite, in part, a user interface including an area for "indicating a number of copies to print with respect to the files that are included in the presentation package." In the Office action, the Examiner has asserted, that Kanerva et al. fails to disclose every element of claims 29-30 and 32 of the present application. The Examiner thus refers to Hicks et al.

As discussed above with reference to claims 3-6, 8, 11-14, 16, 19-22 and 24, Hicks et al. relates to an apparatus for producing variable feature presentation sets. In the Office action, the Examiner asserted that the transparencies, dividers, master set, and handout set(s) disclosed by Hicks et al. are analogous to the various subsets of files of claims 27-30 and 32. The applicant, however, asserts that the several variable feature presentation sets disclosed by Hicks et al. are different from the first and second subsets of files currently recited in claim 27-30 and 32.

The several variable feature presentation sets disclosed by Hicks et al., are various ways to produce output of the same original document. Hicks et al. teaches that these variable feature presentation sets are created by modifying the original document and then adding other elements, on a page-by-page, set-by-set basis. Conversely, the content and layout of each page of the files of claim 27-30 and 32 are determined when each of the files is created and saved, and are the same whether the file is included in the first or in the second subset.

Therefore, Kanerva et al. and Hicks et al., taken either alone or in combination, fail to teach, disclose, or suggest every element of claim 27-30 and 32, as amended herein. Claims 27-30 and 32 are therefore allowable for at least these reasons, and the rejections under 35 U.S.C. § 103(a) must be withdrawn. Furthermore, since claims 27-30 and 32 depend from claim 25, these claims are allowable for at least the same reasons as claim 25, and the rejection of these claims under 35 U.S.C. § 103(a) must be withdrawn.

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Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 23, 2005.



Christie A. Doolittle